



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/366,351	08/02/1999	DUANE GALENSKY	GALENSKY5-2	2958

7590 12/02/2003

MORGAN & FINNEGAN LLP
345 PARK AVENUE
NEW YORK, NY 101540053

EXAMINER

MEKY, MOUSTAFA M

ART UNIT	PAPER NUMBER
----------	--------------

2157

DATE MAILED: 12/02/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/366,351

Applicant(s)

GALENSKY ET AL.

Examiner

Moustafa M Meky

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2157

1. The amendment filed on 9/22/2003 has been entered and considered by the examiner.
2. Claims 1-69 are presenting for examination.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-8, 10-11, 13-17, 20-25, 27-28, 30-37, 39-48, 50-51, 53-55, 59-61, 63-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Jones (US Pat. No. 6,175,822).

5. As to claims 1, 63-64, Jones shows in Fig 1 (see col 3, lines 53-64), a device 20 for receiving and playing a multimedia file (audio file, see col 4, lines 13-14, lines 54-57, col 5, lines 5-6) from a multimedia server 14 over a wireless network (see col 4, lines 51-52), comprising:

Art Unit: 2157

- * a microprocessor (not shown in the Fig), see col 5, lines 32-36;
- * a transceiver (not shown in the Fig) for receiving successive blocks of data at initial data rate which is reduced upon receipt of a predetermined amount of data, see col 3, lines 65-67, col 4, line 1, lines 4-6, col 4, lines 25-27, lines 9-14, lines 26-28;
- * a buffer (not shown in the Fig) for temporarily storing the received blocks of data, see the abstract, lines 5-7, col 5, lines 62-65, col 6, lines 22-26, col 7, lines 8-10, lines 16-17; and
- * an output (speaker) for playing the processed blocks of data, see the abstract, lines 7-9, col 4, lines 1-4, lines 6-8, lines 21-24, col 9, lines 4-5, lines 19-22.

6. As to claims 2-3, Jones shows that the blocks of data are received in a digitized and compressed format in different transmission rate, and the data is decoding and decompressed by the microprocessor, see col 5, lines 32-39, lines 62-67, col 6, lines 1-10.

7. As to claim 4, Jones shows the use of a non-volatile memory for storing the decoding, decompression program, and a program for transmitting a signal to a streaming device 14, see col 5, lines 62-67, col 6, lines 1-10, col 7, lines 5-20.

8. As to claims 5, 7 & 65-69, Jones shows the use of a memory for storing the received blocks for subsequent playback, see col 5, lines 37-39, lines 62-65, col 6, lines 22-25.

9. As to claim 6, Jones shows a visual display (monitor) for displaying the file's name, see col 6, lines 37-40, lines 47-48, col 7, lines 12-16, col 8, lines 51-61.

10. As to claim 8, Jones shows that the file is a digital audio file, see col 4, lines 13-14, lines 54-57, col 5, lines 5-6.

Art Unit: 2157

11. As to claims 10-11, Jones shows that the output is an audio speaker, see the abstract, lines 7-9, col 4, lines 1-4, lines 6-8, lines 21-24, col 9, lines 4-5, lines 19-22.

12. As to claims 13-16, Jones shows the claimed limitations of adjusting the transmission rate based upon the buffer's size, see col 5, lines 62-67, col 6, lines 1-10, col 7, lines 5-20.

13. As to claim 17, Jones shows that the device is portable, see col 4, lines 45-53, col 8, lines 24-29.

14. As to claims 20-25, 27-28, 30-37, 39-48, 50-51, 53-55, 59-61, the claims are similar in scope to claims 1-8, 10-11, 13-17, 63-69, and they are rejected under the same rationale.

Therefore, it can be seen from paragraphs 5-14 that Jones anticipates claims 1-8, 10-11, 13-17, 20-25, 27-28, 30-37, 39-48, 50-51, 53-55, 59-61, 63-69.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 9, 12, 18-19, 26, 29, 38, 49, 52, 56-58, 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones.

Art Unit: 2157

17. As to claims 9, 12, Jones shows in Fig 1, a device 20 for receiving and playing a multimedia file from a multimedia server 14 over a wireless network as been discussed in paragraph 5 above. However, Jones does not show that the multimedia is a digital video file and that the monitor is the output to display the file. Since, the system of Jones has the capability to digitize the incoming audio signals and stored the digitized signals in the storage 16, therefore, there is no restriction to digitize any incoming data such as video data as far as the system is able to do the process of digitizing the incoming signals. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Jones to deal with the video signals in addition to the audio signals in order to enable the user to have the privilege to watch a video file in addition to listening to an audio file.

18. As to claims 26, 29, 49, 52, the claims are similar in scope to claims 9 & 12, and they are rejected under the same rationale, see paragraph 17 above.

19. As to claims 18, 19, Jones does not show the use payment process to bill the user for each received file. The process of billing a user for receiving and playing a file from a streaming server was well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Jones to include the billing process in order to obtain revenue for the service system.

20. As to claims 38, 56-58, 62, the claims are similar in scope to claims 18-19, and they are rejected under the same rationale.

Art Unit: 2157

Therefore, it can be seen from paragraphs 5-13 that the modified system of Jones teaches the limitations of claims 9, 12, 18-19, 26, 29, 38, 49, 52, 56-58, 62.

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. .

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2157

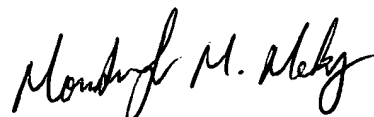
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Moustafa M. Meky whose telephone number is (703) 305-9697. The examiner can normally be reached on week days from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached on (703) 308-7562. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The fax number for official correspondence/amendment is (703) 872-9306.

M.M.M

November 27, 2003



MOUSTAF A M. MEKY
PRIMARY EXAMINER